

### REMARKS

Claims 1, 3, 11, 13, 19, and 21-23 are pending in the present application. Claims 1, 11, and 19 have been amended to clarify claimed subject matter and/or correct informalities. Support for the amendments can be found in the original specification at least at page 6, paragraph [0011]; pages 11-12, paragraph [0023]; in Figures 5 and 8. No new matter has been introduced by these amendments.

Claims 1, 3, 11, 13, 19, and 21-23 are for consideration upon entry of the present amendment. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application.

#### *Claim Rejections 35 U.S.C. §112, 1<sup>st</sup> paragraph*

A. Claims 1, 3, 11, 13, 19, and 21-23 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

B. Claims 1, 3, 11, 13, 19, and 21-23 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Applicant has amended the independent Claims 1, 11, and 19 to clarify the subject matter. For example, Applicant deleted the word “spiral” from spiral groove and added “attaching a plurality of wire or cable engaging attachments to the end portion of the fish tape”. Support may be found at least at pages 11-12, paragraph [0023] and in Figure 5.

Thus, no new matter has been introduced. Applicant respectfully submits that Claims 1, 3, 11, 13, 19, and 21-23 now comply with 35 U.S.C. §112, first paragraph and as a result the rejections are now moot.

**Claim Rejections 35 U.S.C. §112, 2nd paragraph**

Claims 1, 3, 11, 19, and 21-23 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims benefit from the same legal argument as directed above. Applicant has amended the claims to clarify the subject matter and support may be found at least at pages 11-12, para. [0023] and Figure 5. Thus, no new matter has been introduced. Applicant respectfully submits that these claims now comply with 35 U.S.C. §112, second paragraph and as a result the rejection is now moot.

**Claim Rejections Under 35 U.S.C. §102(b)**

Claims 1, 3, 19, 21, and 23 stand rejected under 35 U.S.C. §102(b), as allegedly anticipated by U.S. Patent No. 4,926,518 to Mikol. Applicant respectfully traverses this rejection.

**Independent Claim 1** has been amended to clarify the subject matter, which is directed to a fish tape. Claim 1 recites:

*A fish tape, comprising:*

*a longitudinal portion comprising a circular outer diameter, wherein the circular outer diameter, and defining a solid substantially cylindrical shape along the longitudinal portion of the fish tape, wherein the solid substantially cylindrical shape comprises a plurality of spiral grooves defined along the circular outer diameter and extending along the longitudinal portion;*

*wherein the longitudinal portion of the fish tape comprising the plurality of spiral grooves and the plurality of spiral grooves allow the fish tape to substantially flex in at least one vertical direction and in at least one horizontal direction relative to an axis of the cylindrical shape; and*

*an end portion comprising a groove extending from the end portion partially along the longitudinal portion, wherein the groove*

*provides one or more mechanisms for attaching a plurality of wire or cable engaging attachments to the end portion of the fish tape.*

#### Mikol Fails to Disclose Solid Core, Spiral Grooves, and End Portion

Mikol is directed towards a drain auger to clean out tubes or pipes, such as sink drain pipes (col. 1, lines 5-6). For example, several of Mikol's figures, including Figure 3, illustrate notches 11 that may be extended by radial slit 13, which extends inwardly from the outer surface of the auger toward the axis of the auger (col. 2, lines 52-57). As shown in Figure 3A, the slits [13] should have a minimum width, preferably with a longitudinal opening [14] at the end (col. 4, lines 3-5). Portions of Figures 3 and 3A from Mikol illustrate the notch 11, the radial slit 13, and the longitudinal opening 14.

Figure 3, Mikol

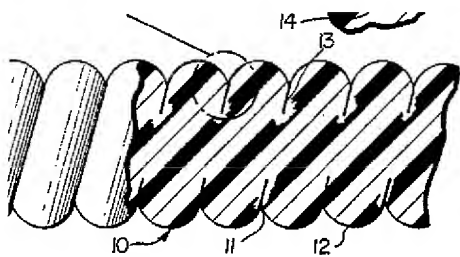
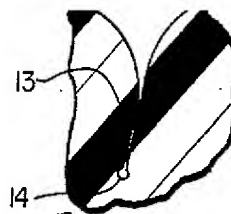
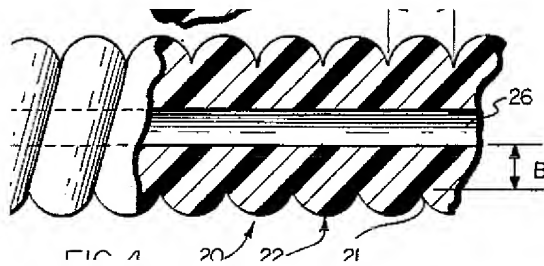


Figure 3A, Mikol



In addition, Figure 4 of Mikol, shows a hollow cylindrical core 26 is used to increase flexibility (col. 3, lines 7-10). Conversely, a solid cylindrical core may be used to decrease flexibility of the auger (col. 3, lines 10-12). For convenience, Applicant reproduces portions of Figure 4 of Mikol.

Figure 4, Mikol



This evidence does not disclose expressly or inherently “a solid substantially cylindrical shape along the longitudinal portion of the fish tape, wherein the solid substantially cylindrical shape comprises a plurality of spiral grooves, a plurality of spiral grooves allow the fish tape to substantially flex in at least one vertical direction and in at least one horizontal direction, and an end portion comprising a groove providing mechanism for attachment”, as recited in Claim 1. Thus, Mikol describes a hollow cylindrical core to increase flexibility and notches extended by radial slit with a longitudinal opening at the end. There is no endpoint mentioned in Mikol. This evidence is insufficient to support a prima facie anticipation rejection of the claimed subject matter.

Furthermore, the Office stated that the Mikol device is capable of performing the intended use recited in the claims, i.e., is capable of functioning as a fish tape (Office Action, page 3). Applicant respectfully disagrees, for at least the reasons set forth below in response to the rejections based on 35 U.S.C. § 103(a).

**Independent Claim 19** is amended to recite features similar to those in Claim 1 and hence benefits from the same arguments directed above to Claim 1.

**Dependent Claim 3, 21, and 23** depend directly from one of independent Claims 1 and 19, and thus are allowable as depending from an allowable base claim. These claims are also allowable for their own recited features that, in combination with those

recited in Claim 1, are not disclosed by Mikol. Applicant asserts Mikol fails to anticipate independent these claims because Mikol does not disclose the recited features of the claimed subject matter. Accordingly, Applicant requests withdrawal of the §102 rejections of these claims.

**Claim Rejections Under 35 U.S.C. §103(a)**

**B. Claims 11, 13, and 22** stand rejected under 35 U.S.C. §103(a), as allegedly unpatentable over Mikol. Applicant respectfully traverses these rejections.

Applicant traverses the rejection of independent Claim 11 because Mikol is non-analogous art. For the purposes of evaluating obviousness of claimed subject matter, the particular references relied upon must constitute “analogous art” (MPEP §2141.01(a)). The art must be from the same field of endeavor, or be reasonably pertinent to the particular problem with which the inventor is involved.

Regarding the first prong of the above analysis, Mikol is not from the same field of endeavor as the Applicant’s subject matter. Mikol is directed to a drain auger cleaning device. Mikol’s device is used to clean out tubes or pipes manually or by machine. In contrast, Applicant’s subject matter pertains to fish tapes used to pull wires through conduits or other raceways. Thus, Mikol is clearly not from the same field of endeavor as is Applicant’s subject matter.

Turning now to the second prong of the above analysis, Mikol is not reasonably pertinent to the particular problem with which Applicant is involved. As noted above, Mikol is directed to an auger cleaning device to scrape the drainpipe free from obstructions and debris buildup. In Mikol, the auger is rotated manually or with use of a

motor to scrape the drainpipe. In contrast, Applicant's subject matter pertains to using fish tapes to pull wires through conduits or other raceways. Thus, Mikol's device does not address the problem of pulling wires through an area that may not be accessible, such as conduits or other raceways. As such, Mikol is not reasonably pertinent to the particular problem addressed by Applicant.

Because it fails both prongs of the above analysis, Mikol is non-analogous art, and any §103 rejection based on Mikol is improper. On at least this basis, the Applicant requests reconsideration and withdrawal of the stated §103 rejections of Claim 11.

Turning now to the stated motivation for combining Mikol and Prior Art Figure 1, the Office stated the motivation for providing a reel would have been obvious as "a convenient means of storing and dispensing the Mikol elongate member" (Office Action, page 4). Applicant respectfully disagrees and submits that this motivation is not well reasoned, because there is nothing in either of the references that would suggest this motivation. "Convenience" is not well reasoned as a motivation because Mikol cleans drains by rotating the auger manually or with use of a motor. Thus, storing and dispensing the elongate member in a reel would be an inconvenience rather than a convenient means. Thus, this rejection is improper.

Furthermore, regarding the stated motivation for combining Mikol and Prior Art Figure 1, Mikol does not provide any motivation to combine its teachings with Prior Art Figure 1. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) MPEP §2143.01. Applicant submits that modifying Mikol as proposed in the Action may

defeat or destroy the stated purpose of Mikol. More specifically, storing and dispensing the Mikol device would destroy Mikol's intended purpose as a drain auger cleaning device that is manually rotated or with use of a motor.

As stated in MPEP §2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Mikol describes a solid cylindrical core that may be used to decrease flexibility of the auger, while the claimed subject matter discloses "*a solid substantially cylindrical shape along the longitudinal portion of the fish tape comprising the plurality of spiral grooves and the plurality of spiral grooves allow the fish tape to substantially flex in at least one vertical direction and in at least one horizontal direction relative to an axis of the cylindrical shape*". Thus, Mikol, considered as a whole, teaches away from the claimed subject matter, a solid cylindrical core comprising a plurality of spiral grooves to substantially flex. Therefore, Mikol does not teach Claim 1.

Neither Mikol nor Prior Art Figure 1 teach or suggest at least the foregoing features, whether considered alone or in combination. Additionally, Mikol is non-analogous art, relative to the claimed subject matter. Finally, Mikol and Prior Art Figure 1 are not properly combined under §103. Accordingly, Mikol and Prior Art Figure 1 do not support a §103 rejection of Claim 11. Applicant thus requests reconsideration and withdrawal of the stated rejection of Claim 11.

**Claim 13 and 22** depend directly from independent Claim 11. Thus, the comments directed above to Claim 11 apply equally to Claims 13 and 22. Accordingly,

Applicant requests reconsideration and withdrawal of the §103 rejections of Claims 11, 13, and 22.

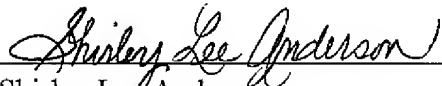
**Conclusion**

All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the present application. If any issues remain that preclude issuance of the application, the Examiner is urged to contact the undersigned attorney before issuing a subsequent Action.

Respectfully Submitted,

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